

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

OK TO ENTER: /BJM/

In re the Application of

Ake SJOBERG

Confirmation: 1992

Serial No.: 10/580,255

Group Art Unit: 1791

Filed: June 7, 2006

Examiner: MUSSER, BARBARA J

For: **PROCESS FOR THE MANUFACTURING OF A DECORATIVE
SURFACE ELEMENTS WITH A SURFACE STRUCTURE**

REQUEST FOR RECONSIDERATION AFTER FINAL REJECTION

Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

Dear Sir:

Reconsideration of the rejections as set forth in the Office Action of September 14, 2011, are respectfully requested in view of the following comments.

In any rejection under 35 U.S.C. 103(a) for unpatentability, it is the Examiner's initial burden to establish the elements of the claimed invention. Thus, even before the Examiner can reach the conclusion of obviousness, he or she must locate the claimed elements in the prior art and may not substitute speculation, hindsight or unfounded assumptions merely because the Examiner has doubts that the invention is patentable. As the Court of Customs and Patent Appeals stated in *In re Warner*, 379, F.2d 1011, 1017 (1967):

"In making such a [section 103] rejection, the examiner has the initial duty of supplying the requisite factual basis and may not, because of doubts the invention is patentable, resort to speculation, unfounded assumptions or hindsight reconstruction to supply deficiencies in the factual basis".

With these guidelines in mind, reconsideration of the rejection of claims 1, 7-10, 15 and 16 under 35 U.S.C. 103(a) as being unpatentable over Drees et al. in view of Chen et al '678 is respectfully requested.

The Examiner points out that Drees et al discloses that it is known to make a decorative laminate by applying a decorative sheet and a protective wear layer to a core material of particle board or medium density fiberboard (MDF) and then heating and bonding the layers in a laminate press which bonds the layers together, citing paragraphs [0004]-[0005].

However, the Examiner is correct that Drees et al does not disclose recessed and protruding portions on either the particle board or MDF core. Therefore, when the Examiner suggests that when an embossed core is heated in the laminate press of Drees it imparts its surface structure to the other layers is incorrect and not based on any factual teachings of the references. There is no teaching whatsoever that Drees imparts any surface structure (smooth or embossed) to the other layers in the laminate press. All that is stated in Drees is that "high pressure and low pressure laminates are normally bonded, with a suitable adhesive or glue, to a rigid substrate such as particle board or medium density fiber board (MDF)..." and there is no suggestion whatsoever of imparting the surface structure of the core to the other layers. See generally paragraph [0004] of Drees et al.

On the other hand, Chen et al '678 does not disclose the "imparting the surface structure of the core to the other layers" nor does he show that the use of an embossed core reshapes a decorative sheet nor does he teach that the textured surface of the core is "in register with" any pattern on a decorative surface sheet.

On the contrary, although Chen et al '678 teaches that surface covering panel "has at least one backing layer or support surface" and furthermore that "the core(s) and/or base coating(s) have a textured surface" (paragraph [0022]) it is clear that there is no sheet or

pattern being reshaped by this textured surface. As clearly disclosed in paragraph [0015], [0022] and specifically in paragraph [0028] the “printed pattern or design located on the base coating is “preferably an ink jet printed pattern. In other words, the printed pattern is not a pattern printed on a paper or other substrate and then applied to the surface of the panel like conventional laminate manufacturing processes” (emphasis added). Thus, there is no decorative sheet being reshaped by the textured base coating or core of Chen et al ‘678.

Thus, when the Examiner combines the Drees et al teaching with the Chen et al ‘678 teachings, there is still no teaching of “imparting a surface structure to a decorative surface sheet comprising cellulose impregnated with a resin” as in the claimed invention as contained in independent claim 1 and by statute (35 U.S.C. 112 fourth paragraph) to any dependent claim, directly or indirectly dependent, on claim 1. Thus, it is clear that the Examiner lacks any teaching of the claimed process steps of the claims subject to rejection over the combination of Drees et al and Chen et al ‘678. Accordingly, withdrawal of the rejection is respectfully requested.

Reconsideration of the rejection of claim 2 under 35 U.S.C. 103(a) as being unpatentable over Drees et al and Chen et al ‘678 as applied to claim 1 above and further in view of O’Brien et al (U.S. Patent 6,551,678) is requested.

O’Brien et al is cited to show how to machine a pattern into a substrate, but it does not correct the foregoing deficiencies noted above with regard to the proposed combination of Drees et al and Chen et al ‘678 and because claim 2, dependent on claim 1, incorporates by reference all the limitations of claim 1 the citation of this combination of three references still does not establish a *prima facie* case of obviousness for the missing limitations of the process steps of claim 2. Withdrawal of the rejection is therefore respectfully requested.

Reconsideration of the rejection of claims 3-6 under 35 U.S.C. 103(a) as being unpatentable over Drees et al and Chen et al ‘678 as applied to claim 1 and further in view of Duvall (U.S. Patent 2,803,188) is respectfully requested. Again, Duvall is only cited to show

how to apply a pattern to a fiberboard core and does not correct the foregoing deficiencies of the combination of Drees et al and Chen et al '678 in teaching how to impart surface structure to a decorative sheet comprising cellulose impregnated with a resin as set forth in independent claim 1 and on which each of dependent claims 3-6 are directly dependent thereon. For the foregoing reasons, no *prima facie* case of obviousness can be made out by the combination of Drees et al, Chen et al '678 and Duvall as to claims 3-6 which incorporate all the limitations of independent claim 1. Withdrawal of the rejections is therefore respectfully requested.

Reconsideration and withdrawal of the rejection of claims 11, 13 and 14 under 35 U.S.C. 103(a) as being unpatentable over Drees et al in view of Chen et al '678 as applied to claim 1 above and further in view of Cannady, Jr. (U.S. Patent 3,948,713) is respectfully requested.

As before, the citation of Cannady, Jr. does not correct the foregoing deficiencies of the combination of Drees et al in view of Chen et al '678 as applied to claim 1 and accordingly no *prima facie* case of obviousness can be stated when the deficiencies of Drees et al and Chen et al '678 as applied to claim 1 and which are incorporated by reference in each of claims 11, 13 and 14 are not corrected by Cannaday, Jr. et al. However, the claims also add the specific feature of not only imparting the surface structure of the core to the decorative surface sheet comprising cellulose impregnated with a resin from below but also applying from above a microstructure through use of a press foil arranged on top of the wear layer during pressing. Thus, the proposed combination of references do not teach three additional steps recited in claims 11, 13 and 14. Withdrawal of the rejections is therefore respectfully requested.

Reconsideration and withdrawal of the rejection of claims 1, 2, 7, 8, 12, 15 and 16 under 35 U.S.C. 103(a) as being unpatentable over Drees et al in view of Rauch (U.S. Patent 3,492,194). The deficiencies of Drees et al have already been discussed, which remarks are

herein incorporated by reference. As before, Drees et al not only lacks a pattern of recess and protruding portions on a particle board core but also does not teach the imparting of the recess and protruding portion to a decorative surface sheet comprising cellulose impregnated with a resin as specified in independent claim 1. The Examiner cites Rauch as "discloses it is known when forming panels to emboss a wood surface and cover it with a colored plastic film which can have a variety of embossed designs" (citing column 1, lines 25-43). However, in the claimed invention, applicants are imparting to a decorative surface sheet comprising cellulose a surface structure comprising recessed and protruding portions of the core. There are no recessed and protruding portions of the core being imparted to a cellulose containing sheet in the cited Rauch et al reference.

Each of dependent claims 2, 7, 8, 12, 15 and 16 incorporate all of the limitations of independent claim 1 upon which they are dependent (35 U.S.C. 112 fourth paragraph) and, thus, are likewise patentable over the combination of Drees et al in view of Rauch. Withdrawal of the rejection is respectfully requested.

Reconsideration of the rejection of dependent claims 9 and 10 under 35 U.S.C. 103(a) as being unpatentable over Drees et al and Rauch as applied to claim 8 above and further in view of Chen et al '678; as well as the rejection of claims 11, 13 and 14 under 35 U.S.C. 103(a) as unpatentable over the combination of Drees et al and Rauch as applied to claim 1 above and further in view of Cannady, Jr. et al, are respectfully requested. As before, each of these dependent claims 9-11, 13 and 14 incorporate by statute (35 U.S.C. 112 fourth paragraph) the limitations of independent claim 1 and the deficiencies in the combination of Drees et al in view of Rauch as applied to claim 1 above are neither cured by Chen et al '678 or Cannady Jr. et al, and accordingly, the rejections fail to state a *prima facie* case of obviousness.

RESPONSE TO THE EXAMINER'S ARGUMENTS

Whether the core of Drees et al is smooth and therefore comprises a smooth texture, there is no teaching that the Drees et al core smooth shape is imparted to the paper layer as instantly claimed. Furthermore, Chen et al pattern is not a decorative laminate in the sense that the printed pattern applied in Chen is a inkjet printed pattern and Chen et al specifically teaches away from using a pattern printed on a paper or other substrate which is applied to the surface of the panel; see in particular Chen et al paragraph [0028]. Thus, the "printed pattern" of Chen et al is not equivalent and is, in fact, completely opposite to a decorative sheet of cellulose having a printed pattern thereon as used in the present invention and therefore as neither Drees et al nor Chen et al teach imparting to a cellulose sheet the recessed and protruding portions a core, the combination of references fails to establish a *prima facie* case of obviousness for the clearly recited process steps of independent claim 1, and all claims directly or indirectly dependent, thereon are not shown in the proposed combination of reference.

In view of the foregoing, withdrawal of all rejections and passage of the application to issue are respectfully requested.

The Director is hereby authorized to charge any deficiency in the fees filed, asserted to be filed or which should have been filed herewith (or with any paper hereafter filed in this application by this firm) to our Deposit Account No. 14-1437, under Order No. 8688.047.US0000.

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Respectfully submitted,



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